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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,391	11/09/2001	Sheng-Shing Li	PP/1-22278/P5/CGC 2069	2361
324	7590	10/22/2009		
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			EXAMINER CHOI, PETER Y	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 10/22/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/045,391	Applicant(s) LI ET AL.	
	Examiner PETER Y. CHOI	Art Unit 1794	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1,2,7-12,17-19 and 25.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Peter Y Choi/
Examiner, Art Unit 1794

/Andrew T Piziali/
Primary Examiner, Art Unit 1794

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue that the references do not provide any motivation to substitute UNITHOX 420 for an alkoxyated alcohol of Mor. Examiner respectfully disagrees. It should be noted that UNITHOX 420 is not claimed. As set forth in the Final Rejection of August 18, 2009, Mor teaches that the alkoxyated fatty alcohol has from "about 8 to about 22 carbon atoms" and therefore, Mor does not limit the alkoxyated fatty alcohol to only those from 8 to 22 carbon atoms. Technical Release 4022.0 is relied on to teach commercially available ethoxyated aliphatic alcohols, available at the time the invention was made and suitable for use as surfactants, wherein the ethoxyated aliphatic alcohols have hydrophilic and lipophilic portions, wherein the hydrophilic portion is a substantially similar ethoxyated alcohol as Mor and wherein the hydrophobic or lipophilic portion is a substantially similar aliphatic saturated hydrocarbon chain as Mor. Based on the totality of the prior art combination, it would have been obvious to one of ordinary skill in the wettable polymer fiber art at the time the invention was made to form the wettable polypropylene fiber of Mor, substituting the ethoxyated fatty alcohol of Mor with UNITHOX 420, as taught by Technical Release 4022.0, motivated by the desire of forming a conventional wettable polymer fiber with a commercially available wetting agent suitable for use in textile processing and finishing and processing aids, and such a substitution of an ethoxyated fatty alcohol wetting agent for another ethoxyated fatty alcohol wetting agent yields a predictably resulting wettable polyolefin fiber to one of ordinary skill in the art.

Applicants argue that the performance of UNITHOX 420 as a melt additive to improve the wettability of the polyolefin fibers is unexpected and not predictable. Examiner respectfully disagrees. As set forth in the Final Rejection of August 18, 2009, different compounds will invariably produce different results. However, Applicants have not shown how the results are unexpected and/or not predictable. For example, each of UNITHOX 420, UNITHOX 480, UNITHOX 750, and UNITHOX 550 each comprise various hydrophilic and lipophilic portions. However, Technical Release 4022.0 specifically recites that the relative efficiency of the hydrophilic and lipophilic portion of the molecule can be controlled by varying the starting alcohol and/or the amount of ethylene oxide (Technical Release 4022.0, page 1). Therefore, since each of the UNITHOX compounds comprise varying combinations of hydrophilic and lipophilic portions, the UNITHOX compounds will invariably comprise varying characteristics and properties. Additionally, Applicants are not claiming any specific wettability characteristics. Therefore, Applicants' arguments are not commensurate in scope with the claimed invention. Additionally, Applicants have not shown that the prior art combination is necessarily differentiated from the claimed invention, as Applicants' Rule 132 Declarations do not compare the claimed invention to the closest prior art. Since the prior art combination teaches an identical commercially available wetting agent, the prior art combination appears to render obvious the claimed invention.

Additionally, mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. In re Wiseman, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). The fact that Applicants have recognized another advantage which would naturally flow from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).